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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/585,485	10/17/2007	R. Richard Gochring	332.1145US	3702

7590 10/06/2010
DAVIDSON DAVIDSON & KAPPEL LLC.
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NEW YORK NEW YORK, NY 10018

EXAMINER

CHANG, CELIA C

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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10/06/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/585,485	Applicant(s) GOEHRING ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/6/06, 11/9/07, 7/20/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application is a national stage of PCT/US05/02824.
Claims 21-76 have been canceled. Claims 1-20 are pending.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun et al. US 6,867,222 (corresponding to 2003/0069249 cited on 1449) in view of Soudijn et al. CA 87:23277; Teranishi et al. CA95:132947 or Obase CA 99:122375.

Determination of the scope and content of the prior art (MPEP §2141.01)

Sun et al. '222 disclosed analogous process of making analogous compound, see col. 33-34 scheme in example 1 and col. 14-16 2-cyanoamino bezimidazolylpiperidine formula IV or Iva.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the prior art and the instant claims is that instead of exemplification of the process with benzimidazolyl compounds, the flow description is drawn to benzoxazolyl compounds. However, the instant benzimidazolyl compounds have been generically disclosed by sun et al. '222 to be analogous variation among formula I-IV, and the general procedure for making the compounds is applicable to the generically described compounds. In order for the chemical process of the prior art to be operable for the formula IV or Iva, at the time the invention was made, the starting material must be available. Soudijn et al. CA 87:23277; Teranishi et al. CA95:132947 or Obase CA 99:122375 demonstrated that at the time the invention of sun et al. '222 was made, the analogous starting material is readily available.

Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)

One in possession of the sun et al. '222 reference would expect that all the generically described process to be operable for the generically described compounds guided by the

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examples of the references. The evidence of available starting material so that alternative compounds can be made by the exemplified procedure rendered the instant claims *prima facie* because one having ordinary skill in the art would expect all the description of the prior art reference to be operable especially the starting material, although not exemplified, are well recognized in the prior art to be known and available. In absence of unexpected results, there is nothing unobvious in choosing some among many. In re Lemin 141 USPQ 814.

The dependent claims are more limited in temperature, solvents, or isolation of intermediates are effect oriented parameters of chemical process. To optimize such effect oriented parameter is an obvious variation in the chemical art. In re Szumski 133 USPQ 551. In re Geisler 43 USPQ2d 1362. In re Boesch 205 USPQ 215. Pfizer Inc. v. Apotex Inc. 82 USPQ2d 1321.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sun et al. US 6,867,222 (corresponding to 2003/0069249 cited on 1449) in view of Soudijn et al. CA 87:23277; Teranishi et al. CA95:132947 or Obase CA 99:122375 further in view of US Atkinson et al. 3,737,464.

The finding of *prima facie* obvious of the base claims 1-8, 10-20 over Sun et al. US 6,867,222 (corresponding to 2003/0069249 cited on 1449) in view of Soudijn et al. CA 87:23277; Teranishi et al. CA95:132947 or Obase CA 99:122375 has been clearly delineated *supra* and hereby incorporated by reference. The dependent claim 9 employing a deuteration step using deuterated halide is a well known step for such purpose. The further incorporation of a *prima facie* obvious process of a conventional modification for the very same purpose of the conventional step is *prima facie* obvious in the chemical art since the motive, suggestion and expectation of success are well recognized by chemists.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Sept. 29, 2010

/Celia Chang/
Primary Examiner
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